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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/534,757

05/13/2005

Tutomu Sakamoto

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EXAMINER

ROCCA, JOSEPH M

ART UNIT

PAPER NUMBER

3616

MAIL DATE

DELIVERY MODE

08/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/534,757	Applicant(s) SAKAMOTO, TUTOMU	
	Examiner Joseph Rocca	Art Unit 3616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant in amended claim 1 recites "an outer tube portion surrounding the outer tube portion," based on this claim language it is unclear what structure is being described. Thus, the claim is indefinite, vague, and unclear, under 35 U.S.C. 112, second paragraph, because one cannot determine what the applicant is claiming. Accordingly, the claims below will be rejected on the merits in the manner that this limitation is best understood.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by JP 58-30811 (1983).

An upper mount comprising a body-side member fixed to a body and a suspension-side member fixed to a suspension, wherein

the body-side member comprises an inner tube portion and an outer tube portion surrounding the outer tube portion (Figs. 1 and 2) (as is best understood by examiner [see 35 U.S.C. 112(2) rejection]),

the suspension-side member (Figs. 1 and 2) is formed in a hollow circular shape and slidably mounted to the body-side member with a sealed space formed between the suspension-side member and the body-side member (Fig. 2);

the inner tube portion (Fig. 2) of the body-side member is arranged to be inserted into a hollow region of the suspension-side member and the suspension-side member is arranged to be inserted into the outer tube portion of the body-side member, when the suspension-side member is mounted to the body-side member (Fig. 2),

the outer tube portion of the body-side member is provided with at least one fluid passage hole (Fig. 2) for supplying a fluid to the sealed space from outside and at least another fluid passage hole for discharging the fluid from the sealed space; and

a spacing of the sealed space of the suspension-side member is made changeable by supplying the fluid to the sealed space (Fig. 2).

5. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2-60736.

An upper mount comprising a body-side member fixed to a body and a suspension-side member fixed to a suspension, wherein

the body-side member (Figs. 3 and 4) comprises an inner tube portion and an outer tube portion surrounding the inner tube portion (Figs. 3 and 4, as is best understood by examiner),

the suspension-side member is formed in a hollow circular shape and slidably mounted to the body-side member with a sealed space formed between the suspension-side member and the body-side member (Figs. 3 and 4);

the inner tube portion (Figs. 3 and 4, Element 10) of the body-side member is arranged to be inserted into a hollow region of the suspension-side member and the suspension-side member is arranged to be inserted into the outer tube portion of the body-side member, when the suspension-side member is mounted to the body-side member,

the outer tube portion (Figs. 3 and 4) of the body-side member is provided with at least one fluid passage hole for supplying a fluid to the sealed space from outside and at least another fluid passage hole for discharging the fluid from the sealed space (Figs. 3 and 4); and

a spacing of the sealed space of the suspension-side member is made changeable by supplying the fluid to the sealed space (Figs. 3 and 4).

Moreover, with respect to claim 2, JP 2-60736 is characterized in that a stopper (Figs. 3 and 4, portion that extends laterally from element 15) that makes the spacing of

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the sealed space constant is provided on the body-side member (note particularly, Fig. 3, how portion is resting on the stopper and it is keeping sealed space constant).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2-60736 in view of Fujii (U.S. 4,216,977). JP 2-60736 additionally discloses all of the limitations of claim 3, except it does not appear to specifically disclose the use a mechanism providing fluid to the sealed space from a pump via an electromagnetic valve, although said valves are old and well known in the art. Fujii discloses a mechanism for providing fluid to the sealed space from a pump via an electromagnetic valve for use in suspension systems for vehicles (Fig. 1; Col. 1, to Col. 4, Line 35). It would have been obvious to one of ordinary skill in the art at the time of invention to have further modified JP 2-60736 to utilize electromagnetic valves, in view of the teachings of Fujii, so as to provide a convenient, efficient and reliable means for actuating the system taught by the combination of JP 2-60736. Moreover, making this modification would be obvious under 35 U.S.C. 103(a) as the result obtained is no more than the simple substitution of one known element for another or the mere application of

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a known technique to a piece of prior art ready for improvement yielding a predictable result that is old and well known in the art.

Response to Arguments

8. Applicant's arguments with respect to claims 1-3 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Rocca whose telephone number is 571-272-5191. The examiner can normally be reached on 8:30 AM to 5:00 PM, Monday through Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Dickson can be reached on 571-272-6669. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Joseph Rocca
Patent Examiner
AU-3616

 8/4/07
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